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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,732

05/17/2007

Andrew Ian Cooper

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UNILEVER PATENT GROUP
800 SYLVAN AVENUE
AG West S. Wing
ENGLEWOOD CLIFFS, NJ 07632-3100

EXAMINER

NEGRELLI, KARA B

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

07/30/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentgroupus@unilever.com

Office Action Summary	Application No. 10/587,732	Applicant(s) COOPER ET AL.	
	Examiner KARA NEGRELLI	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 2,9 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

POROUS BODIES AND METHOD OF PRODUCTION THEREOF

Response to Amendment

1. The Terminal Disclaimer filed on June 15, 2009 is not sufficient to overcome the copending application No. 10/587,734 or copending application No. 10/587,722 references. The Terminal Disclaimer has an improper electronic signature (the forward slash is missing at the end of the name). Appropriate action is required.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Any rejections stated in the previous Office Action and not repeated below are withdrawn.
4. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on June 26, 2009. In particular, claims 1 and 11 have been limited to water soluble porous bodies, and to specify that a water-insoluble material is incorporated into said lattice to be dispersed when the water soluble porous body dissolves. The porous body is clarified to be a water-soluble lattice containing water-insoluble "payload" material, as distinguished from the cited art.
5. It is noted that the newly introduced limitations were not present at the time of the preceding action. For this reason it is proper to make the present action FINAL.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

8. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/587,734. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims and the referenced claims are directed to the same subject matter which is: a porous body comprising water-soluble polymer, surfactant, and a hydrophobic material and a method of making a porous body containing water-soluble polymer and surfactant. The instant claims and the claims of the reference are nearly identical with the exception that the instant application requires less than 10% by weight of a water-soluble polymeric material other than a surfactant, 5 to 95% by weight of a surfactant, and a hydrophobic material to be dispersed when the polymeric material dissolves, while the copending application requires 10% - 95% by weight of a water-soluble polymeric material other

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than a surfactant, 5 to 95% by weight of a surfactant, and does not teach a hydrophobic material in claim 1. Although the amount of polymeric material is 10% to 95% in the reference and less than 10% in the instant application, it is the examiner's position that the values are close enough that one of ordinary skill in the art would have expected the same properties. Case law holds that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Furthermore, although the hydrophobic material of instant claim 1 is not recited in claim 1 of the reference application, the hydrophobic material is recited in claims 8 and 10 of the reference application.

10. This is a provisional obviousness-type double patenting rejection.

11. Claims 1-3, 5, 8-14, 16, and 18-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5-10, and 12-18 of copending Application No. 10/587,722. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims and the referenced claims are directed to the same subject matter which is: a porous body comprising water-soluble polymer, surfactant, and a hydrophobic material and a method of making a porous body containing water-soluble polymer and surfactant. The instant claims and the claims of the reference are nearly identical with the exception that the instant application requires less than 10% by weight of a water-

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soluble polymeric material other than a surfactant, 5 to 95% by weight of a surfactant, and a hydrophobic material to be dispersed when the polymeric material dissolves, while the copending application requires 10% - 95% by weight of a water-soluble polymeric material other than a surfactant, 5 to 95% by weight of a surfactant, and does not teach a hydrophobic material in claim 1. Although the amount of polymeric material is 10% to 95% in the reference and less than 10% in the instant application, it is the examiner's position that the values are close enough that one of ordinary skill in the art would have expected the same properties. Case law holds that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Furthermore, although the hydrophobic material of instant claim 1 is not recited in claim 1 of the reference application, the hydrophobic material is recited in claims 8 and 10 of the reference application.

12. This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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14. Claims 1 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Claims 1 and 11 recite water soluble porous bodies comprising a three dimensional oil and water emulsion templated open-cell lattice, wherein the lattice contains a) less than 10% by weight of a water-soluble polymeric material other than a surfactant, (b) from 5 to 95% by weight of a surfactant, and (c) a water-insoluble material incorporated into said lattice to be dispersed when the water soluble porous body dissolves. The scope of the claim is unclear because one of ordinary skill in the art could not determine whether the (c) component is incorporated as part of the lattice, or whether components (a) and (b) form the lattice, and (c) is contained within the lattice.

16. As recited, the scope of the claim is unclear because the claimed “porous bodies” are produced from a lattice containing a combination of (a), (b), and (c), and component (c), the “water-insoluble material [is] incorporated into said lattice to be dispersed when the **water-soluble porous body dissolves**,” said lattice of which the porous bodies are comprised.

17. Claim 1 recites “(c) a water-insoluble material incorporated into said lattice to be dispersed when the water-soluble porous body dissolves...” This statement implies that the water insoluble material will only be incorporated into the lattice after the dissolution of the porous body. However, the porous body is comprised of the lattice, therefore when the porous body dissolves, the lattice will also dissolve. Because it is unclear as to

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whether the scope of the claim encompasses (c) being incorporated into the lattice as the lattice dissolves or whether (a) and (b) forms the lattice into which (c) is incorporated and (c) is released when the lattice comprised of components (a) and (b) is dissolved.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1, 3-4, 11, 13, and 16 are rejected under 35 U.S.C. 103(a) as obvious over Fujimoto et al. (Patent Abstracts of Japan, Publication no. 01011141).

20. As to claims 1-3, 11, 13, 16, and 20-22 Fujimoto (Abstract, 62166603) teaches a porous article by combining an aqueous solution, a uniform aqueous suspension or the mixture of a hydrophilic polymer (cellulose or polyvinyl alcohol, which are both water soluble) having a concentration of 0.05 to 50%, preferably 0.1 to 10% with 0.5 to 50% of surfactant having an HLB value of 2 to 20, and freeze drying the mixture to attain a product of thickness 5-100 mm. Because the porous articles comprise water soluble polymers (cellulose or PVA), one of ordinary skill in the art could reasonably conclude that the porous article of Fujimoto is water soluble.

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21. Fujimoto et al. do not expressly teach that the polymeric compositions have an intrusion volume as measure by mercury porosimetry of at least about 3 mL/g.

However, since the same composition that is disclosed in claim 1 is taught in Fujimoto et al., one of ordinary skill in the art would expect that the composition of Fujimoto et al. would have the same properties as the composition disclosed in claim 1, and would therefore have the specified intrusion volume. Furthermore, one of ordinary skill in the art would recognize that a porous article could comprise a molded body.

22. Claims 1, 3-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (US 5,025,004) and further in view of Kitagawa (US 6,048,908).

23. As to claim 1, Wu et al. teach a process for preparing solid, powdered, polymeric compositions (column 3, lines 6-8) comprising at least one polymeric, water soluble or water dispersible, nonionic emulsifier (column 3, lines 51-53) in an amount of from 0.5 to 70% (column 4, lines 17-18), an additive in an amount from 10 to 25% weight which can include surfactants such as Tween 80 (column 8, lines 51-60), and at least one water insoluble polymer (column 3, line 45 and column 6, lines 4-53). The powders taught by Wu et al. have a particle size in the range of from 10 μm to 30 μm (meaning the particles are not spheres with a diameter of from 0.2 to 0.5 mm) (column 8, lines 37-39). Wu et al. do not expressly teach that the polymeric compositions have an intrusion volume as measure by mercury porosimetry of at least about 3 mL/g. However, since the same composition that is disclosed in claim 1 is taught in Wu et al., one of ordinary skill in the art would expect that the composition of Wu et al. would have the same

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properties as the composition disclosed in claim 1, and would therefore have the specified intrusion volume.

24. Wu et al. do not specify that the powdered polymeric materials are porous. However, Kitagawa teaches porous hydrophilic microbeads, produced using a formulation which comprises from 0.5 to 50% by weight monomer (column 7, lines 53-56) and 1 to 30% weight of surfactant (column 9, lines 4-8), said microbeads of which are used for drug carriers (column 15, lines 3-7). One of ordinary skill in the art would expect that if the powdered polymeric compositions of Wu et al. were porous, it would aid the medicaments for which it is used (column 3, lines 5-10) in distribution throughout the body (Kitagawa, (US 6,048,908), column 15, lines 4-5).

25. As to claims 3-4, Wu et al. teach the process for preparing the composition as applied to claim 1, wherein the powdered polymeric materials can comprise cellulose acetate phthalate (See examples). Because the powdered polymeric materials of Wu et al. can comprise cellulose acetate phthalate, a water soluble polymeric material, one of ordinary skill in the art would reasonably conclude that the powdered polymeric materials of Wu et al. are capable of dissolving in water.

26. As to claims 5 and 7 Wu et al. teach the process for preparing a composition as applied to claim 1 in which the surfactant is nonionic Tween 80, polyethylene glycol sorbitan monooleate (column 8, line 60).

27. As to claim 6, Wu et al. do not specify that the surfactant used in the invention is solid at ambient temperature. However, Kitagawa teaches the use of distearate as a surfactant which is solid at room temperature (column 8, lines 52-54).

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28. As to claim 8 Wu et al. teach the process for preparing the composition as applied to claim 1, further comprising at least one water insoluble polymer (column 8, lines 25-26) and a water soluble polymers (column 8, lines 56-59). Wu et al. further teach dispersing the powdered, polymeric composition into an aqueous solution (column 8, lines 45-46).

29. As to claim 10, Wu et al. teach the process for preparing the composition as applied to claim 1, and further teach that said composition can be used to prepare a cosmetic composition, said cosmetic composition of which contains at least one active ingredient such as a UV absorber (column 9, lines 45-53).

30. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (US 5,025,004) and further in view of Kitagawa (US 6,048,908) and Monforte et al. (US 3,551,533).

31. As to claim 11-12, Wu et al. teach preparing solid, powdered, polymeric compositions (column 3, lines 6-8) comprising at least one polymeric, water soluble or water dispersible, nonionic emulsifier (column 3, lines 51-53) in an amount of from 0.5 to 70% (column 4, lines 17-18) and additionally comprising an additive in an amount from 10 to 25% weight which can include surfactants such as Tween 80 (column 8, lines 51-60). Wu et al. further teach that the composition contains at least one water-in-oil emulsifier (column 3, lines 50-68).

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32. Wu et al. further disclose that the composition comprises an organic solvent (liquid medium) (column 3, lines 44-48). Wu et al. also teach passing the polymer solution-in-water emulsion through a particle size reduction means such that the polymer is in the form of droplets having an average size in the range of about 0.1 to 0.8 μm , followed by removing the organic solvent to form aqueous dispersion, and drying the dispersion to form the water dispersible powder (column 4, lines 45-62). Wu et al. teach drying the particles by freeze drying (column 8, lines 17-20).

33. Neither Wu et al. nor Kitagawa expressly teach the steps of freeze drying the porous materials. One of ordinary skill in the art would recognize that freeze drying employs a fluid freezing medium used to rapidly freeze a composition and further employs drying by sublimation. For example, Monforte et al. teaches breaking up a solute material into fine droplets, rapidly freezing the droplets to prevent coalescence (freeze-drying) and removal of the solvent by sublimation (column 1, lines 46-54). The dried droplets of Monforte et al. are porous (column 1, line 57).

34. As to claims 13, Wu et al. teach the process for preparing the composition as applied to claim 1, wherein the polymeric material can comprise cellulose acetate (column 6, lines 11).

35. As to claims 14 and 16-17, Wu et al. teach the process for preparing a composition as applied to claim 1 in which the surfactant is nonionic Tween 80, polyethylene glycol sorbitan monooleate (column 8, line 60).

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36. As to claim 15, Wu et al. do not specify that the surfactant used in the invention is solid at ambient temperature. However, Kitagawa teaches the use of distearate as a surfactant which is solid at room temperature (column 8, lines 52-54).

37. As to claim 18-19, Wu et al. and Kitagawa teach the polymeric compositions as applied to claim 11. Kitagawa teaches porous hydrophilic microbeads, produced using a formulation which comprises from 0.5 to 50% by weight monomer (column 7, lines 53-56) and 1 to 30% weight of surfactant (column 9, lines 4-8), said microbeads of which are used for drug carriers (column 15, lines 3-7). Kitagawa further teaches that the discontinuous oil phase can be about 10%, about 20%, about 30%, about 40%, about 50% or about 60%, and as high as 99% of the emulsion (column 11, lines 38-50).

38. As to claim 20, Wu et al. and Kitagawa teach the polymeric compositions as applied to claim 11 which further comprises solvents including alicyclic hydrocarbons, ethers, and esters (column 5, lines 31-43).

39. As to claim 21, Wu et al. teach the composition as applied to claim 11 and further teach dispersing the powdered, polymeric composition into an aqueous solution (column 8, lines 45-46).

40. It would have been obvious for one of ordinary skill in the art to combine Wu et al. and Kitagawa because both disclose compositions comprising acrylate polymers (Kitagawa, column 7, lines 27-28; Wu et al., column 6, line 29) and surfactants (Kitagawa, column 8, lines 54; Wu et al., column 8, line 60) to make hydrophilic, water

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dispersible products used in pharmaceuticals (Kitagawa, column 15, lines 4-6; Wu et al., column 3, line 6-9).

Response to Arguments

41. Examiner notes that the amendment necessitated the new grounds of rejection of claims 1, 3-4, 11, 13, and 16 as rejected under 35 U.S.C. 103(a) as obvious over Fujimoto et al. (Patent Abstracts of Japan, Publication no. 01011141).

42. Applicant's arguments filed June 26, 2009 have been fully considered but they are not persuasive.

43. Applicant argues that the bodies disclosed by Wu et al. are dispersible but not soluble in water. However, the particles disclosed in Wu et al. comprise cellulose acetate phthalate, which is capable of dissolving in water (See Steiner, US Patent No. 4,997,599, column 2, lines 43-45).

44. Applicant further argues that if the particles disclosed in Kitagawa are also insoluble, given that the polyHIPE materials are used as "super-absorbers" and would not be much use as absorbers if they dissolved. However, Kitagawa teaches microbeads which can be used as carriers to provide sustained release of an agent such as a fragrance, a cosmetic (which is also disclosed in Wu et al. at column 3, lines 9-12), or insecticides, which are all examples taught in the instant specification (Kitagawa, column 14, line 66 – column 15, line 2). Kitagawa also teaches the microbeads of the invention are well-suited to be drug microcarriers (column 14, lines 3-5). To release the fragrance, cosmetic, insecticide, or drug, the microbead would *have*

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to be capable of dissolving. Therefore, the invention of Kitagawa is concerned with the delivery of water insoluble materials via a carrier which is water soluble.

45. Applicant argues that Monforte does not teach emulsions, or polymers with surfactants, and that Monforte provides a general disclosure about freeze-drying an atomized liquid. However, note that while Monforte et al. do not disclose all the features of the present claimed invention, the Monforte et al. reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention.

Conclusion

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

47. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARA NEGRELLI whose telephone number is (571)270-7338. The examiner can normally be reached on Monday through Friday 8:00 am EST to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KARA NEGRELLI/
Examiner, Art Unit 1796

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796